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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,716	10/17/2003	Meike Niesten	PO7829/LeA 36,212	4652

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BAYER MATERIAL SCIENCE LLC
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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,716

Applicant(s)

NIESTEN ET AL.

Examiner

Patrick D. Niland

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1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/03, 2/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claims recite "a hydrophobic polyether polyacrylate (A) including". It is unclear what is intended by "including". It is unclear if other components are required to be present and if so what they are to be. It is unclear if "including" is intended to have the same meaning as "comprising" or some other meaning.

B.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 5-8, and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 6130285 Melchioris et al..

Melchioris discloses the instantly claimed solvent free binder mixtures at the abstract, of which the hydroxyl acrylate falls within the scope of the instantly claimed component A3; column 2, lines 30-67; column 3, lines 1-67; column 4, lines 1-67, particularly 60 and 63-67, which falls within the scope of the instant claim 7, the OH content and viscosity of lines 50-56

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falls within the scope of the instant claim 5, and the method of this column falls within the scope of the instant claim 8; column 5, lines 1-67; column 6, lines 1-67, particularly 6-27; columns 7 and 8, Table 1; and the remainder of the document. The patentee is silent as to the instantly claimed water absorption but since the binder mixture is otherwise the same as that of the instant claims, it must necessarily and inherently possess the instantly claimed water absorption.

Column 6, lines 62-67 falls within the scope of the instant claims 10-11. Table 2 of column 9 shows the shore D hardness of the patentee's coatings to fall within the scope of the instant claim 12. Column 7, lines 5-10 falls within the scope of the instant claims 13-14.

5. Claims 1-2, 5-8, and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6130285 Melchior et al. in view of US Pat. Application Pub. No. 2002/0028875 Anderle et al..

Melchior et al. discloses the instantly claimed solvent free binder mixtures at the abstract, of which the hydroxyl acrylate falls within the scope of the instantly claimed component A3; column 2, lines 30-67; column 3, lines 1-67; column 4, lines 1-67, particularly 60 and 63-67, which falls within the scope of the instant claim 7, the OH content and viscosity of lines 50-56 falls within the scope of the instant claim 5, and the method of this column falls within the scope of the instant claim 8; column 5, lines 1-67; column 6, lines 1-67, particularly 6-27; columns 7 and 8, Table 1; and the remainder of the document. The patentee is silent as to the instantly claimed water absorption but since the binder mixture is otherwise the same as that of the instant claims, it must necessarily and inherently possess the instantly claimed water absorption.

Column 6, lines 62-67 falls within the scope of the instant claims 10-11. Table 2 of column 9

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shows the shore D hardness of the patentee's coatings to fall within the scope of the instant claim

12. Column 7, lines 5-10 falls within the scope of the instant claims 13-14.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients of Melchiors because they are disclosed by the patentee and would have been expected to give a coating having the properties described by the patentee. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed fatty alcohols, particularly castor oil, in the compositions of Melchiors because Melchiors, column 6, lines 65-67 says that known coating additives may be added and Anderle, section [0047], lines 6-7 thereof shows castor oil (ricinoleic acid) to be a known plasticizer for similar coatings and its plasticizing affect would have been expected and desired in the coating of Melchiors.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

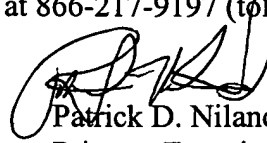
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland
Primary Examiner
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